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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,483	03/30/2001	Taro Tokuhiro	39303.2023900	1512

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,483

Applicant(s)

TOKUHIRO ET AL.

Examiner

Mark Fadok

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Me

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 2-5,7-10 and 12-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 USC 121:

- I. Claims 1,6 and 11, drawn to an apparatus, software and method for instructing multiple vendors to ship utilizing one purchase order, classified in class 705, subclass 26.
- II. Claims 2,7 and 12, drawn to an apparatus, software and method for ordering physical and downloadable products simultaneously and having them shipped with one order, classified in class 705, subclass 26.
- III. Claims 3,8 and 13, drawn to an apparatus, software and method for authenticating a series of computers, classified in class 705, subclass 56.
- IV. Claims 4,9 and 14, drawn to an apparatus, software and method for identifying a stocks location and shipping form designated location, classified in class 705, subclass 22.
- V. Claims 5,10 and 15 drawn to an apparatus, software and method for instructing a facility to manufacture needed parts, classified in class 705, subclass 8.

Inventions I and II are related as subcombinations disclosed as usable together in a combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention II has separate utility such as ***. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above the search required for group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mehran Arjomand on 4/8/2004 a provisional election was made without traverse to prosecute the invention Group I claims 1,6, and 11. Affirmation of this election must be made by the applicant in reply to this Office action. Claims 2-5,7-10 and 12-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The information disclosure statement filed 10/23/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each

publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. All references were considered less the Yahoo reference because it was not available for consideration.

The information disclosure statement filed 3/30/2001 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. There was no Form 1449 available in the file, therefore the IDS filed 3/30/2001 was not considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,6 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "enable" does not provide sufficient distinction for the examiner to ascertain what it is that enabled the feature that follows the term enable.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the

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responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Treatment of Preamble

The examiner has given little patentable weight to the preamble, because the claims are directed to the use of a site computer, therefore the remainder of the preamble is considered to be a recitation of intended use. In order to give the limitations of the preamble weight, the examiner recommends that those limitations in the preamble, which the applicant determines to be distinguishable over the prior art, be moved into the body of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,6, and 11 are rejected under 35 U.S.C. 102(e) as being Anticipated by Treyz et al (6,587,835).

In regards to claim 1, Treyz discloses a site computer communicable through a network with a first vendor computer of a first vendor belonging to a first country, a second vendor computer of a second vendor belonging to a second country different from said first country and a user computer used by a general user, said site computer executing the steps of:

enabling simultaneous designation of items respectively sold by said first and second vendors from said user computer by said general user (FIG 28); and

instructing said first and second vendor computers to send out said items to said general user under conditions of said simultaneous designation of said items respectively sold by said first and second vendors from said general user (FIG 28, Item 352).

In regards to claim 6, Treyz discloses a record medium storing a program used in a site computer communicable through a network with a first vendor computer of a first vendor belonging to a first country, a second vendor computer of a second vendor

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belonging to a second country different from said first country and a user computer used by a general user, said program containing the steps of:

enabling simultaneous designation of items respectively sold by said first and second vendors from said user computer by said general user; and

instructing said first and second vendor computers to send out said items to said general user under conditions of said simultaneous designation of said items sold by said first and second vendors from said general user (see response to claim 1).

In regards to claim 11, Treyz discloses a method for selling items using a site computer communicable through a network with a first vendor computer of a first vendor belonging to a first country, a second vendor computer of a second vendor belonging to a second country different from said first country and user computer used by a general user, said site computer executing the steps of:

enabling simultaneous designation of items respectively sold by said first and second vendors from said user computer by said general user; and

instructing said first and second vendor computers to send out said items to said general user under conditions of said simultaneous designation of said items respectively sold by said first and second vendors from said general user (see response to claim 1).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-**

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4252. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

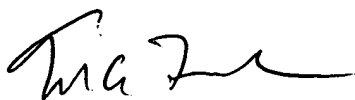
Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner